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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,139	08/03/2001	Blair Winner	BAL6019P0331US	7439

32116 7590 12/31/2002

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER  
500 W. MADISON STREET  
SUITE 3800  
CHICAGO, IL 60661

EXAMINER

PARA, ANNETTE H

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 12/31/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/922,139

Applicant(s)

WINNER, BLAIR

Examiner

Annette H. Para

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-16, 18-21 and 24 is/are allowed.
- 6) ☒ Claim(s) 17, 22, 23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### Drawing

Applicants stated that he would hold the filing of petition until the receipt of allowable subject matter.

Applicants are advised to submit the petition with the next response, since post-allowance communications typically delay the issuance of the patent.

### Status of the Application

Claims 1-11 are cancelled. Claims 12-30 are newly amended. Claims 12-30 are pending. The text of those sections of Title 35, U. S. Code not included in this action can be found in the prior Office action. The amendment was filed with 2 claims numbered "20". The claims have been remembered in accordance with 37 CFR 1.126.

### Written Description

Claims 17, 22, 23, and 25-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *"An applicant shows possession of the claimed invention by describing the claimed invention with **all its limitations**."* MPEP 2163. *"Possession may be shown in many ways. For example, possession may be shown by describing an actual reduction to practice of the claimed invention. Possession may also be shown by a clear depiction of the invention in detailed drawings or in structural chemical formulas which permit a person skilled in the art to clearly recognize that applicant had possession of the claimed invention."* MPEP 2163

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Claim 17 is drawn to seed of hybrid marigold plant of claim 13. The seeds of claim 17 have not been described in the specification. Claims 22-27 are drawn to a second-generation hybrid marigold produced by hybridization with any and all marigold plants. No such hybrids have been described. *"A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process."* MPEP 2163. *"The analysis of whether the specification complies with the written description requirement calls for the examiner to compare the scope of the claim with the scope of the description to determine whether applicant has demonstrated possession of the claimed invention....Generally, there is an inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement. Information which is well known in the art need not be described in detail in the specification."* MPEP 2163 Claim 28-30 are drawn to a progeny of a marigold plant designated 50011 and its parts, which express trait selected from the group consisting of: high xanthophylls production, male sterility and fully double flowers. However, the specification only discloses the deposited seeds obtained from the marigold plant 50011. Applicants have described one or two characteristics, but many characteristics such as leaf size, ray floret morphology, etc., are not described, are unpredictable, and are expected to differ for every sexually produced progeny plant. *"The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of the ordinary skill in the art. For example, consider the claim "A gene comprising SEQ ID NO:1." A determination of what the claim as a whole covers may result in a conclusion that specific structures such as a promoter, a coding region, or other elements are included. Although all genes encompassed by this claim share the characteristics of comprising SEQ ID NO:1, there may be insufficient description of those specific structures (e.g., promoters, enhancers, coding regions, and other regulatory elements) which are also included."* MPEP2163

In analyzing whether the written description requirement is met for genus claims, it is first determined whether a representative number of species have been described by their complete structure. (It is not realistic to expect that the "complete structure" of a plant, or even a cell, could be described.

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Therefore the inquiry required by this portion of the written description guidelines is interpreted to be whether the phenotype of the claimed plant has been described.) In this case, the one disclosed embodiment is not representative of the enormous number of products claimed. The claims encompass every marigold seeds or plants grown from the deposited seeds. Plants have many phenotype traits, which vary independently, so millions of possible phenotypes are possible and claimed. The specification discloses only the marigold plant 50011 and the deposited F<sub>1</sub> seeds but not the distinguishing characteristics of the embryos from these deposited seeds, and not the heterozygous population claimed. Next, then, it is determined whether a representative number of species have been sufficiently described by other relevant identifying characteristics. It is not possible to adequately describe the claimed products because the cross of hybrid plant gives raises of a heterozygous population. One skilled in the art would not have been able to predict all of the resulting phenotypes. The limited disclosure in the specification is not deemed sufficient to reasonably convey to one skilled in the art that Applicants were in possession of the huge genera recited in the claims at the time the application was filed. Thus it is concluded that the written description requirement is not satisfied for the claimed genera.

### **Claim Rejections - 35 USC § 102/103**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art

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to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 28 is rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over PanAmerican Seed (Xanthophyll Marigolds). PanAmerican Seed discloses marigold plants with high xanthophylls production (entire document). The claim does not specify that the claimed plant possesses any other phenotype, which would distinguish it from those of PanAmerican Seed. Thus, the claimed invention as a whole was at least *prima facie* obvious over, if not anticipated by, the prior art.

By stating that the claimed plant has 50011 in its lineage, Applicants are essentially reciting a process for production of the claimed plant. The courts have approved the use of 102/103 rejections for product-by-process claims. See MPEP 2113.

### Conclusion

Claims 12-16, 18-21, 24 are allowed.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (703) 308-6327. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

A.H.P



**BRUCE R. CAMPELL, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600**